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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/026,244	06/04/99	HOCHMAN	48000.1002U

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HM12/1002

EXAMINER

MORAN, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/326,244

Applicant(s)

HOCHMAN, DARYL W.

Examiner

Morjorie Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 2-11 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 2-11 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *detailed action*.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. All rejections and objections not repeated below are hereby withdrawn.

***Title***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested:

METHOD FOR IDENTIFYING OPTICAL CONTRAST ENHANCING AGENTS

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Applicant's arguments with respect to claims 2-11 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Claims 2-4, 7, 11, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by NELSON et al. (US 5,169,944).

NELSON teaches a method of identifying optical contrast enhancing agents useful for enhancing the sensitivity of MRI (i.e. optical) imaging of tissues in an intact organism by exposing the organism to the contrast enhancing agent(s), acquiring test data (MRI images) from the organisms subsequent to exposure to the agent(s) and identifying the agent(s) as useful for enhancing contrast if the test data indicates a change in optical properties by comparison of test data to comparison data (columns 15-17, Examples 5 and 6). NELSON teaches that his signal (enhancement) values are normalized (Figures 5 and 6), thus inherently teaching comparison of his test data to "control" data, therefore claims 4, 11, and 17 are anticipated. NELSON further teaches acquiring multiple test data sets from different spatial locations within his organisms (e.g. Figure 9), and teaches exposure of his organisms to challenge by a biological agent and/or toxin (injection of fecal material, tumor, etc.) prior to acquiring test data (Examples 5 and 6), thereby anticipating claims 2, 3, and 7.

Claims 4, 9 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by TURNER (US 4,812,412).

TURNER teaches a method of evaluating stain and dye performance (i.e. ability to enhance image contrast) in staining cells and tissues wherein dyes is added to cells or tissue specimen and results compared to a nontreated (control) specimen (col. 10, lines 52-58), thereby anticipating claims 4 and 17. TURNER teaches that his evaluation data may include light scattering (col. 10, lines 43-45), thus anticipating claim 9.

Claims 3-8, 10, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by POOT et al (US 6,291,203 B1).

POOT teaches a method of identifying cyanine dyes which are useful in selectively staining mitochondria (i.e. which result increased contrast of mitochondrial staining as compared to other cellular organelles; col. 3, lines 51-52 and col. 7, line 58-col. 8, line 32). POOT teaches comparison of cells/mitochondria stained with his dyes to cells/organelles stained with Rhodamine 123 (col. 19, lines 15-61) and thereby identifies his cyanine dye as ones which increase contrast of mitochondrial staining in cells, thereby anticipating claims 17 and 4. POOT teaches that the cells in his method may be cultured cells or cell lines (col. 8, lines 34-41, thereby anticipating claims 8 and 10. POOT also teaches treatment of his cells with various compounds (test agents or drugs) before addition of his cyanine dyes (col. 8, line 61-col. 9, line 8), thereby anticipating claims 3 and 7. POOT teaches comparison of cells with dye added to cells without dye added (empirical controls) to assess the effect of staining of mitochondria (optical activity of the dye; col. 9, lines 8-15), thereby anticipating claims 5-6.

### ***Conclusion***


Claims 2-11 and 17 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to a patent analyst, Dianiece Jacobs, whose telephone number is (703) 305-3388.

  
Marjorie A. Moran  
September 28, 2001



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